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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,332	07/21/2004	Renato Ancorotti	3687-70	8959

23117 7590 02/23/2007
NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER

AHMED, HASAN SYED

ART UNIT	PAPER NUMBER
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1615

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/500,332

Applicant(s)

ANCOROTTI, RENATO

Examiner

Hasan S. Ahmed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- Receipt is acknowledged of applicant's amendment/remarks, which were filed on 14 November 2006.
- The amendment filed on 14 November 2006 has been entered
- The 35 USC 112 and 101 rejections of record are hereby withdrawn in light of the amendment.
- New claims 18-28 are rejected under 35 USC 102(b).

* * * * *

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Verdon, et. al. (U.S. Patent No. 4,994,264).

Verdon, et. al. disclose a process of making press molded cosmetic composition (see col. 1, line 67 – col. 2, line 2).

The disclosed process is the instant process as claimed:

- the fatty emulsion (solvent and fats) of instant claim 18(a') (see Example, col. 4, line 65 – col. 5, line 23; Example, col. 4, line 65 – col. 5, line 23);
- the coloring powders of instant claim 18(a'') (see col. 3, lines 54-58);

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- the mixing of instant claim 18(b) (see Example, col. 4, line 65 – col. 5, line 23);
- the extruding of instant claim 18(c) (see Example, col. 4, line 65 – col. 5, line 23);
- the drying of instant claim 18(d) (see col. 4, lines 32-36);
- the sizing of instant claim 18(e) (see col. 4, lines 11-13);
- the stearate of instant claim 19 (see Example, col. 4, line 65 – col. 5, line 23);
- the water of instant claim 20 (see col. 2, lines 41-44);
- the preserving agents of instant claim 21 (see col. 3, lines 63-66);
- the coloring powders comprising synthetic and/or natural pigments of instant claim 22 (see col. 3, lines 54-58);
- the ratio of phases of instant claim 23 (see col. 6, line 20);
- the extruding into various shapes and sizes of instant claim 24 (see col. 4, lines 11-13);
- the cosmetic of instant claim 27 (see Example, col. 4, line 65 – col. 5, line 23); and
- the blusher or eye shadow of instant claim 28 (see col. 1, line 17).

The drying processes of instant claims 25 and 26 are not essential to a determination of patentability of the composition disclosed in the claim. As explained by the court in *In re Thorpe et. al.* (CAFC 1985) 779 F2d 695, "A claim to a composition

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defined by reference to the process by which it is produced, is not limited to compositions produced by the process recited in the claim."

* * * * *

Response to Arguments

Applicant's arguments filed 14 November 2006 have been fully considered but they are not persuasive.

1. Applicants argue that a component of the prior art reference is not a component in the instant application. See remarks, page 4.

Examiner respectfully submits that omission of an element from the instant application does not obviate anticipation as it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

2. Applicants argue that the paste disclosed in the prior art reference is always pressed after extrusion while the paste of the instant application is never pressed. See remarks, page 5.

Examiner respectfully submits that pressing of the paste is not essential to a determination of patentability of the composition disclosed in the claim. As explained by the court in *In re Thorpe et. al.* (CAFC 1985) 779 F2d 695, "A claim to a composition defined by reference to the process by which it is produced, is not limited to compositions produced by the process recited in the claim."

* * * * *

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



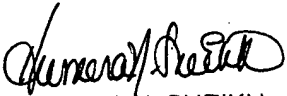
Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hasan S. Ahmed whose telephone number is 571-272-4792. The examiner can normally be reached on 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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PRIMARY EXAMINER
TC-1600